

Amend
aqueous dispersion containing a fine metal or metal alloy conductive powder having a [primary] particle size of up to 20 nm in an amount in the range of from 2.0 to 10.0 wt.%, wherein the [dispersant] dispersion has an electric conductivity of up to 7.0 mS/cm and a pH in the range of from 3.8 to 9.0[, and is used by diluting with a solvent].--

Amend
14. (Amended) A composition according to claim 18, wherein said fine metal powder comprises at least one metal or metal alloy selected from the group consisting of Fe, Co, Ni, Cr, W, Al, In, Zn, Pb, Sb, Bi, Sn, Ce, Cd, Pd, Cy, Rh, Ru, Pt, Ag [and], Au, [and/or] an alloy comprising at least two of said metals, [and/or] a mixture comprising at least two of said metals and[or] a mixture comprising at least two of said alloys.--

REMARKS

The claims have been amended in response to issues raised in the outstanding Office Action. Support for the amendments to Claim 8 is found on page 11, line 16, page 12, line 19 and page 22, line 27. Support for Claim 12 may be found on page 26, lines 13-14. In Claim 14, support for the added range of 0.1 to 20 wt.% of metal is found on page 17, line 23. No new matter is believed to have been introduced by this amendment. Claims 1-30 remain active in the application with Claims 1-7, 10, 11, 13 and 27-30 withdrawn from further consideration.

Claims 1-30 have been restricted under 35 U.S.C. §121. The Applicants affirm their election of Group II, Claims 8, 9, 12, and 14-26. Applicants respectfully traverse the restriction requirement. Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden on the Examiner if restriction is not required (MPEP §803). The Applicants submit that a search of only three

subclasses would not be a serious burden on the Examiner. Therefore, it is respectfully requested that the restriction requirement be reconsidered and withdrawn.

The Applicants wish to acknowledge the interview held on November 23, 1999 between Examiner Dudash and Applicants' U.S. representative. The Examiner's courtesy and helpful suggestions are sincerely appreciated.

Claims 8, 12, and 14-16 have been rejected under 35 U.S.C. §112, second paragraph as indefinite for reasons set forth in paragraph 12 of the Office Action. The claims have been amended and are submitted to be free of any of the terminology found objectionable by the Examiner. It is submitted that this rejection has been obviated by the present amendment.

Claims 8 and 16 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent 4,983,420 to Wolfrum et al for reasons expressed in paragraph 15 of the Office Action. In response thereto, the Applicants point out that the compositions of this reference do not contain a black powder. The aluminum oxide in the suspension of the reference is not a black powder nor is the particle size of the tungsten particles within the range of the present claims. It is submitted that this rejection is inapplicable to Claims 8 and 16.

Claim 8 has been rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 4,387,115 to Kitamura et al for reasons expressed in paragraph 18 of the Office Action. In response to the Examiner's position that it would have been obvious to use carbon black for the purpose of pigmenting the composition of the reference or to contribute to the conductivity of the composition, the Applicants point out that the reference does not disclose using carbon black as a pigment or for the purpose of imparting conductivity. The listing of carbon black in column 9 of the reference contained in a lengthy list of optional ingredients does not suggest the use of the composition for the purpose of pigmenting or providing

conductivity. The presumption is that the carbon black is present merely as a filler. The Applicants respectfully submit that this rejection is inapplicable to amended Claim 8.

Claim 14 has been rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 5,632,833 to Kurano et al for reasons discussed in paragraph 20 of the Office Action. The Applicants submit that the conductive pastes disclosed in this reference are not dispersions and contain a major amount of the conductive metal. Amended Claim 14 now specifies that a dispersant is present and that the amount of metal or metal alloy is present in a maximum of 15 wt.%. Furthermore the pastes of the reference do not disclose or suggest the ranges of particle sizes set forth in Claim 14. Accordingly, it is submitted that this rejection is inapplicable to amended Claim 14.

Claim 9 stands rejected under 35 U.S.C. §103(a) as unpatentable over the Kurano et al patent in view of the Kitamura et al patent for reasons discussed in paragraph 21 of the Office Action. The Applicants submit that the combination of references does not disclose or suggest a composition as set forth in Claim 9. The combined disclosures of the prior art do not disclose a dispersion of a conductive metal having a particle size within the range of that set forth in Claim 8 nor a weight ratio of conductive powder to black powder nor an amount of powder and metal powder and black powder within the presently claimed range. It is respectfully submitted that the rejection of Claim 9 is no longer applicable.

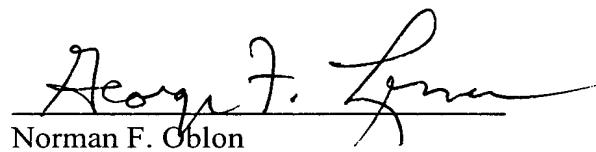
Claims 12, 15 and 19 have been rejected under 35 U.S.C. §103(a) as unpatentable over Kurano et al in view of U.S. Patent 4,950,423 to Sullivan for reasons discussed in paragraphs 23-25 of the Office Action. Claims 18 and 20-25 stand rejected under 35 U.S.C. §103(a) as unpatentable over Kitamura et al in view of U.S. Patent 3,775,176 to Cross et al and Sullivan for reasons discussed in paragraph 26 of the Office Action. Applicants

respectfully submit that the combined teachings of these references does not disclose or suggest compositions as set forth in the amended claims presented herein. It is therefore requested that these rejections be reconsidered and withdrawn as being inapplicable to the presently amended claims.

In view of the above amendments and remarks, it is respectfully submitted that this application is now in allowable condition. An early and favorable indication to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Norman F. Oblon
Attorney of Record
Registration No. 24,618

George F. Lesmes
Registration No. 19,995

Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202
PHONE NO.: (703) 413-3000
FAX NO.: (703) 413-2220